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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,971	08/16/2004	Scott L. Nielson		4970
23553	7590	03/17/2008		
MARKS & CLERK			EXAMINER	
P.O. BOX 957				FREJD, RUSSELL WARREN
STATION B			ART UNIT	PAPER NUMBER
OTTAWA, ON K1P 5S7				2128
CANADA				
			MAIL DATE	DELIVERY MODE
			03/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/710,971	NIELSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Russell Frejd	2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 August 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-33 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-33 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

***Examination of Application #10/710,971***

1. Claims 1-33 of application 10/710,971, filed on 16-August-2004, are presented for examination.

***Abstract Objections***

2. The Abstract of the Disclosure is objected to because of the language purporting the "wide scope of possible implementations". Correction is required. See M.P.E.P. 608.01(b).

- 2.1 Applicant is reminded of the proper content of an Abstract of the Disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

***Claim Objections under 37 CFR 1.75(d)(1)***

3. Claims 3, 7, 14, 18, 25 and 29 are objected to under 37 CFR 1.75(d)(1), wherein each of these claims contains two sentences, each ending with a period.

***Claim Rejections under 35 U.S.C. § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

**4.1** Claims 23-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention claims a computer program to automatically create a three-dimensional nail object.

**4.2** The Examiner posits that claims 23-33 of the present invention are computer executable software code, or a program per se, that implement the method for automatically creating a three-dimensional nail object. For at least this reason, the software instructions of the present invention do not meet the criteria for a statutory process (MPEP Section 2106.01).

### ***Claim Rejections under 35 U.S.C. § 102***

**5.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5.1** Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Yogo et al., hereinafter Yogo, USP Application Publication 2004/0143359.

**5.2** Yogo discloses:

Claims 1, 12, 23: A method to automatically create a three-dimensional nail object [section 0009], comprising: starting with a three-dimensional array of data representing a digitized nail surface [0029], and; measuring key reference points along the X-axis, Y-axis, Z-axis and the periphery of the digitized nail surface [0030], and; selecting a preexisting preferred finished

three-dimensional nail object point array that closely matches the key reference points along the X-axis, Y-axis and Z-axis from a library of pre-created three-dimensional nail object arrays [0041, see "collection saved on the computer system], and; combining the preferred three-dimensional nail object with the digitized nail surface into a new preferred three-dimensional artificial nail object that conforms to an expected result so that the new generated nail object will fit over the digitized nail surface and create a desired artificial nail appearance [0035].

Claims 2, 13, 24: wherein starting with a three-dimensional array of data representing a digitized nail surface includes any data that can be used to represent a three-dimensional object [0030, 0034].

Claims 3, 14, 25: wherein the three-dimensional array of data may be represented as points of data representing an X-axis, Y-axis and Z-axis [0030]. The three-dimensional array of data may also include the points defining the periphery of the digitized nail surface [0030].

Claims 4, 15, 26: wherein measuring key reference points includes determining the measurement value in millimeters or inches of the nail surface along its X-axis, Y-axis and Z-axis [0029 (measurement), 0030 (points)]; where X-axis represents width, Y-axis represents the length and Z-axis represents depth [Fig. 5].

Claims 5, 16, 27: wherein measuring key reference points includes determining the arc of the digitized nail surface along the X-axis and/or determining the arc of the nail surface along the Y-axis [0031, 0033].

Claims 6, 17, 28: wherein measuring key reference points includes evaluating three-dimensional points along the periphery of the nail surface [0030, 0033].

Claims 7, 18, 29: wherein selecting a preexisting finished three-dimensional array of points resembling a preferred nail object includes using the reference points to select and modify an existing finished nail object array from a library of said arrays [0030, see "stored in digital

format"], containing many variations along the X-axis, Y-axis, and Z-axis. The three-dimensional library nail object arrays would appear in every way to be a finished and desired artificial nail object [0041].

Claims 8, 19, 30: wherein combining the library selected nail object array of points with the digitized nail surface includes aligning the digitized nail surface along the bottom surface of the library selected nail object, inasmuch as anywhere that the digitized nail surface intersects the library selected nail object, the digitized nail surface becomes the bottom surface of the library selected nail object [0033, 0035].

Claims 9, 20, 31: wherein combining the library selected nail object with the digitized nail surface includes removing any points of the library selected object around the periphery points of the digitized nail surface so that the library selected nail object will fit directly on top of the digitized nail surface, and eventually fit the digitized nail surface without any voids or points extending beyond the digitized nail surface [0034, 0035].

Claims 10, 21, 32: wherein the combining of the library selected nail object and the digitized nail surface will form a new preferred three-dimensional artificial nail object [0041, see "collection".

Claims 11, 22, 33: wherein the desired nail object in its final state is a customized three-dimensional object representing an artificial nail that is desired, which fits over the digitized nail surface [0035, 0036].

### ***Response Guidelines***

6. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

**6.1 Any response to the Examiner in regard to this non-final action should be**

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**directed to:** Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, or the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279. Inquires of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist (571) 272-2100.

**mailed to:** Commissioner of Patents and Trademarks  
P.O. Box 1450, Alexandria, VA 22313-1450

**or faxed to:** (571) 273-8300

Hand-delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

**Date:** 3-March-2008

/Russell Frejd/  
Primary Examiner AU 2128